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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/043,813 09/29/98 KELLY

M 85010340201

EXAMINER

HM12/0609

SEED & BERRY  
6300 COLUMBIA CENTER  
SEATTLE WA 98104-7092

ART UNIT GUPTA, A PAPER NUMBER

10

DATE MAILED: 1654

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

■ This application has been examined ■ Responsive to communication filed on 3-26-99 □ This action is made final. 06/09/99

A shortened statutory period for response to this action is set to expire 3 Months from the date of this letter.  
Failure to respond within the time period will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENTS ARE PART OF THIS ACTION:

1. □ Notice of References Cited by Examiner, PTO-892.
2. □ Notice re Patent Drawing, PTO-948.
3. □ Notice of Art Cited by Applicant, PTO-1449
4. □ Notice of Informal Patent Application, Form PTO-152.
5. □ Information on How to Effect Drawing Changes, PTO-1474.
6. ■ NOTICE TO COMPLY

Part II SUMMARY OF ACTION

1. ■ Claims 1-6 are pending in the application.  
Of the above claims, \_\_\_\_ are withdrawn from consideration.
2. □ Claims \_\_\_\_ have been cancelled.
3. □ Claims \_\_\_\_ are allowed.
4. ■ Claims 1-6 are rejected.
5. □ Claims \_\_\_\_ are objected to.
6. □ Claims \_\_\_\_ are subject to restriction or election requirement.
7. □ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. □ Formal drawings are required in response to this Office action.
9. □ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are □ acceptable. □ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. □ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_ has (have) been □ approved by the examiner. □ disapproved by the examiner (see explanation).
11. □ The proposed drawing correction, filed on \_\_\_\_ has been □ approved. □ disapproved (see explanation).
12. □ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has □ been received □ not been received □ been filed in parent application, serial no. \_\_\_\_; filed on \_\_\_\_.
13. □ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. □ Other

EXAMINER'S ACTION

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### DETAILED ACTION

1. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.
2. The indicated allowability of claim 2 is withdrawn in view of the new grounds for rejections .
3. All rejections made in the previous office actions are withdrawn.

### *New Ground For Rejections*

#### *Double Patenting*

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 5-6 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 34 and 56 of copending Application No. 08/751,300. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 54 of copending Application No. 08/751,300. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason. The copending claims are drawn to a pharmaceutical formulation where as the claims of the instant application are drawn to compounds. However such a variant is obvious because in producing the desired pharmaceutical formulation, one would have to necessarily have the isolated compounds.


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Note the co-pending application has been allowed and when a patent number has been issued to this application, this rejection will be changed from a provisional to a non-provisional.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can normally be reached on (703) 308-0254. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Anish Gupta

  
Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600

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Application No. 09/043,813

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821 - 1.825 for the following reason(s):

1. ☒ This application clearly fails to comply with the requirements of 37 CFR 1.821 - 1.825. Applicant's attention is directed to these regulations, published at 1114 O.G. 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
2. ☐ This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c).
3. ☐ A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
4. ☐ A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of the marked - up "Raw Sequence Listing."
5. ☐ The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
6. ☐ The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
7. Other: \_\_\_\_\_

Applicant must provide:

☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing"

☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification

☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e) or 37 CFR 1.821(f) or 37 CFR 1.821(g) or 37 CFR 1.825(b) or 37 CFR 1.825(d).

For questions regarding compliance with these requirements, please contact:

For Rules Interpretation, call (703) 308 - 1123

For CRF submission help, call (703) 308 - 4212

For PatentIn software help, call (703) 557 - 0400

Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600